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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,283

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EXAMINER

SCHEUERMANN, DAVID W

ART UNIT

PAPER NUMBER

2834

MAIL DATE

DELIVERY MODE

03/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,283	Applicant(s) MUROTA ET AL.	
	Examiner DAVID W. SCHEUERMANN	Art Unit 2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction Requirement & Election of Species Requirement

Restriction between Product and Process Claims

Restriction to one of the following inventions is required under **35 U.S.C. 121**:

- I. Claims 1-19, drawn to a rotary electric machine with adjustable axial gap, classified in class 310, subclass 91.
- II. Claim 20, drawn to a method of manufacturing a rotary electric machine with adjustable axial gap, classified in class 29, subclass 596.

The inventions are *a priori* distinct, each from the other because of the following reasons: Inventions II and I are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (**MPEP § 806.05(f)**). In the instant case the process claimed can be used to make another and materially different product such as an adjustable position or pressure rotary hydraulic machine tool.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is PROPER.

Election of Species Requirement

Additionally, this application contains claims directed to the following patentable distinct species:

Specie I: Figure 2

Specie II: Figure 4

Specie III: Figure 5

The species are *a priori* independent or distinct because each of the Species, grouped supra, is disclosed as separate and distinct Species, set forth by the Applicant's disclosure. That is, each of the Specie groupings articulated by the associated

Figure(s), *supra*, has been described by the Applicant's specification as being exclusive and distinct from the other Groupings.

Serious Burden

Additionally, each of the various disclosed species is shown to have diverse and exclusive characteristics. A search for one of these mutually exclusive characteristics is not coextensive with a search for the other mutually exclusive characteristics and therefore searching for all mutually exclusive characteristics could not be done without ***serious burden***.

Moreover still, the search for one distinctly claimed and mutually exclusive specie, is not required for the other(s).

The Examiner *additionally* maintains that each identified Species and/or Restriction invention Grouping, as articulated in the Restriction & Election of Species Requirement, *supra*, would impose other grave, serious burdens upon the Examiner. Moreover, in accordance with **37 CFR 1.104**, to the nature of each distinctly grouped Species and/or Grouping, the Examiner must make a thorough study thereof and a thorough investigation of the available prior art relating to the claimed subject matter of each distinctly identified Species and/or Grouping. The examination for each distinct Specie/Groping must be complete with respect both to compliance of the application

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with the applicable statutes and rules and to the patentability of the invention as claimed, in addition to matters of form, including **Title 35** to the United States Code, sections **101**, **102**, **103** and **112**, to each distinctly grouped invention.

Moreover, each separately grouped specie/invention must be thoroughly searched, including, but not limited to, various searching fields, inclusive of differing text search strategies and/or queries, determination of anticipation, if any, of uncovered prior art, potential application of the Graham factual inquiries to each distinct specie/invention to review for any indicia of possible obviousness, etc.

Moreover still, as has been held, if there is an express admission that the claimed inventions would have been obvious over each other within the meaning of **35 U.S.C. § 103**, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

There is nothing on record, at present, to show that the distinctly grouped species/inventions are obvious variants.

Moreover, the Applicant has not established that each of the aforementioned Product, Process and/or Species are not separately patentable, nor has Applicant submitted evidence or identified such evidence now of record showing the Product, Process and/or Species to be obvious variants or clearly admit on the record that this is the case. If the Applicant were to include such a statement, ***the election/restriction requirement would be withdrawn.*** In either instance, however, if the Examiner finds

one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Thus, in addition to electing one of the Product or Process Groups, *supra*, the Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Additionally, the Applicant being the inventor of the claimed subject matter, is asked to identify which claims are considered generic to the Applicant's claimed subject matter. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

If the Applicant traverses the election/restriction requirement, the Examiner will judiciously assay the traversal to determine whether the Applicant has admitted, either implicitly or explicitly, that the restricted inventions and/or species bear no patentable distinctness between each Grouping, Specie and/or sub-grouping(s) and subspecie(s), as set forth, *supra*.

Should Applicant traverse on the ground that the inventions or Species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or Species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Because these inventions are **independent or distinct** for the reasons given above and the search for the multiple, mutually exclusive species would impose a grave, **serious burden** and hardship upon the Examiner, for at least the reasons articulated, *supra*, restriction for a priori examination purposes as indicated is **PROPER**.

Independent "or" Distinct

More specifically, as set forth in **MPEP § 803**:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (**MPEP § 806.04 - § 806.04(i)**) *or* distinct (**MPEP § 806.05 - § 806.05(i)**). [Emphasis in bold italics added].

Moreover as set forth in MPEP § 802.01, the meaning of independent "and" distinct within the context of Patent Office restriction policy and practice is articulated as follows:

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In **37 CFR 1.141**, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent," of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that **35 U.S.C. 121**: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the **1952 Act**, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section **121** of the **1952 Act** were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent

inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent," indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

Thus, clearly, the restriction is proper if the Examiner shows that the inventions are distinct or independent, but not necessarily both independent *and* distinct.

Rejoinder Considerations Pertaining to Product & Process Claims

As it pertains to the restriction between the product and process claims, the following should be noted. Where Applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with **37 CFR 1.104**. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of

35 U.S.C. §§ 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See **MPEP § 821.04(b)**. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of **35 U.S.C. 121** does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See **MPEP § 804.01**.

Rejoinder Considerations Pertaining to Species Election

As it pertains to the restriction between the distinctly identified Species, supra, the following should be noted.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional Species which depend from or otherwise require all the limitations of an allowable generic claim as provided by **37 CFR 1.141**. If claims are added after the election, Applicant must indicate which are readable upon the elected species. **MPEP § 809.02(a)**.

In the event of rejoinder, the requirement for restriction between the distinctly grouped Species will be reconsidered, and any rejoined claims will be fully examined for

patentability in accordance with **37 CFR 1.104**. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of **35 U.S.C. §§ 101, 102, 103 and 112**. Withdrawn Species claims that do not depend from an allowed generic linking claim will not be rejoined. Further, note that the prohibition against double patenting rejections of **35 U.S.C. 121** does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See **MPEP § 804.01**.

Joint Inventor(s), if Any

If there is more than one inventor, the following should be noted: Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with **37 CFR 1.48(b)** if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under **37 CFR 1.48(b)** and by the fee required under **37 CFR 1.17(i)**.

Conclusion

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE **(1) MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of **37 CFR 1.136(a)**. In no event, however, may a reply be timely filed after **SIX (6) MONTHS** from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become **ABANDONED (35 U.S.C. § 133)**. Any reply received later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID W. SCHEUERMANN whose telephone number is (571)272-2035. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached at (571) 272-2044. The fax phone numbers for the organization where this application is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/D. W. S./
Examiner, Art Unit 2834

/Karl I.E. Tamai/
Primary Examiner, Art Unit 2834
March 28, 2008